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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,155	12/10/2001	Gerd M. Muller	740105-81	7221

22204 7590 08/25/2005

NIXON PEABODY, LLP  
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WASHINGTON, DC 20004-2128

EXAMINER
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DABNEY, PHYLESHA LARVINIA

ART UNIT	PAPER NUMBER
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2646

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/010,155

Applicant(s)

MULLER ET AL.

Examiner

Phylesha L. Dabney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 12-60 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 8 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

This action is in reference to the request for reconsideration filed 22 September 2004 in which claims 1-11 are pending, claims 12-33 were withdrawn, and claims 34-60 were cancelled.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “two sealing members axially spaced of claim 2, which still satisfied the requirement of the sealing members being in the intermediary region of claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to teach two sealing members located in the intermediate regions (claim 1) that is axially spaced.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In addition to the rejection above, it is not understood how these sealing members are in the intermediate region as well as at the end of the cylindrical portion.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leysieffer et al (U.S. Patent No. 5,999,632) in view of Gunnersen et al (U.S. Patent No. 6,795,562).

Regarding claims 1 and 5, Leysieffer teaches a fixation element (20) for an implantable microphone, wherein the fixation element comprises an essentially cylindrical portion (14) adapted to be inserted into a bore (fig. 1) which crosses a wall of the auditory canal of a user, the cylindrical portion, at least in an implanted state of the fixation element having an axial length corresponding to the axial length of the bore, and surrounding an outer circumferential portion of a housing part of the microphone (11), which housing part is provided with a sound receiving member (13).

Leysieffer does not teach the cylindrical portion includes at least one elastic region of increased diameter that is located at least in an intermediate region of its axial length, the elastic region contacting, in the implanted state of the fixation element, a wall of the bore at least in an intermediate region of its axial length and providing, by elastic restoring forces, for a friction which is sufficiently high to fix the cylindrical portion in at least one of the two axial directions of the bore (fig. 1).

In a similar field of endeavor, Gunnensen teaches a cylindrical portion (6) including at least one elastic region (fig. 2; col. 4 lines 54-57) of increased diameter having the means (13) in the intermediate region for providing a secure fit in a bore (4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an intermediate elastic region on the cylindrical portion of Leysieffer as taught by Gunnensen for a secure fit.

Regarding claim 2, the combination of Leysieffer and Gunnensen teaches the region of increased diameter is defined by at least one sealing member (Gunnensen; 13), which is adapted to sealingly contact the wall of the bore upon the cylindrical portion having been inserted into the bore.

Regarding claim 11, the combination of Leysieffer and Gunnensen teaches the cylindrical portion is connected to a flange portion (Leysieffer; 24, 25) of increased diameter, the flange portion, in the implanted state, contacting the side of the wall of the auditory canal remote from the skin of the auditory canal.

Claims 1, 2, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maltan et al (U.S. Patent No. 2003/0086583) in view of Gunnensen et al (U.S. Patent No. 6,795,562).

Regarding claims 1 and 5, Maltan teaches a fixation element for an implantable microphone, wherein the fixation element comprises an essentially cylindrical portion (figs. 6a-

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6b; 61) adapted to be inserted into a bore (40) which crosses a wall of the auditory canal of a user, the cylindrical portion (figs. 6a-6b; 61), at least in an implanted state of the fixation element having an axial length corresponding to the axial length of the bore, and surrounding an outer circumferential portion of a housing part (60) of the microphone, which housing part is provided with a sound receiving member (80), wherein the cylindrical portion includes at least one elastic region of increased diameter, the elastic region contacting, in the implanted state of the fixation element, a wall of the bore and providing, by elastic restoring forces, for a friction which is sufficiently high to fix the cylindrical portion in at least one of the two axial directions of the bore.

Maltan does not teach the cylindrical portion includes at least one elastic region of increased diameter that is located at least in an intermediate region of its axial length, the elastic region contacting, in the implanted state of the fixation element, a wall of the bore at least in an intermediate region of its axial length and providing, by elastic restoring forces, for a friction which is sufficiently high to fix the cylindrical portion in at least one of the two axial directions of the bore.

In a similar field of endeavor, Gunnensen teaches a cylindrical portion (6) including at least one elastic region (fig. 2; col. 4 lines 54-57) of increased diameter having the means (13) in the intermediate region for providing a secure fit in a bore (4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an intermediate elastic region on the cylindrical portion of Maltan as taught by Gunnensen for a secure fit.

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Regarding claim **2**, the combination of Maltan and Gunnersen teaches the region of increased diameter is defined by at least one sealing member (Gunnersen; 13) which is adapted to sealingly contact the wall of the bore upon the cylindrical portion having been inserted into the bore.

Regarding claim **11**, the combination of Maltan and Gunnersen teaches the cylindrical portion is connected to a flange portion of increased diameter, the flange portion (Maltan; distal end of 61), in the implanted state, contacting the side of the wall of the auditory canal remote from the skin of the auditory canal.

#### ***Allowable Subject Matter***

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7-8 are allowed.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

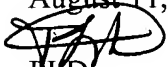
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phylesha L. Dabney whose telephone number is 571-272-7494. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, Fridays 8:30-4 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 11, 2005

  
PLD

  
**SUHAN NI**  
**PRIMARY EXAMINER**